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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,968	01/17/2002	Reinhold Holtkamp SR.	030502/0147	5426

22428 7590 08/07/2007

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/07/2007

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10046968	1/17/02	HOLTKAMP, REINHOLD	030502/0147

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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

Wendy C. Haas

ART UNIT	PAPER
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1661

20070803

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Commissioner for Patents

Section (9) Grounds of Rejection, appearing on page 3 of the Examiner's Answer mailed February 23, 2006 should be corrected to read as follows:

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The Examiner incorporates the Enablement and Written Description rejections set forth in the final Office Action mailed December 2, 2004. The rejections are located beginning with the second paragraph of Page 2 and ending with the third paragraph on Page 6. They state, in full, the following:

Claim Rejections 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Enablement

Claims 1-3 and 5-8 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for multi-florescent African Violet plants derived from the deposited material and methods using the same, does not reasonably provide enablement for multi-florescent African violets made by any other method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to: (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

In the present case, the claims are broadly directed to all African violets comprising at least one leaf axil that produces more than one flower stem (A). The nature of the invention is a mutant African violet plant comprising a dominant, transmissible, genetic trait that produces plants that comprise at least one leaf axil that produces more than one flower stem (B). The prior art contains no African violet plants that comprise at least one leaf axil that produces more than one flower stem, nor does it teach or suggest any methods for producing an African violet plant that comprises at least one leaf axil that produces more than one flower stem (C). A person of skill in the art would not be able to mutate an African violet plant to produce at least one leaf axil that produces more than one flower stem without undue experimentation. A person of skill in the art would be able to produce an African violet plant comprising at least one leaf axil that produces more than one flower stem by crossing a plant grown from applicant's deposited seed with another African violet plant or by crossing any progeny of applicant's original multi-florescent African violet plant with an African violet plant containing a desirable trait (D). The art is unpredictable. Applicants' specification notes that the mutant multi-florescent trait was discovered in only one plant, 'SB 4-2 Muflo', grown from a group of 25,000 seeds that were exposed by NASA to cosmic radiation and zero gravity for a period of six years (E). The amount of direction provided by the inventor appears to be sufficient and is not significant to the analysis of this particular invention, as claimed (F). The specification contains working examples of known progeny of 'SB 4-2 Muflo' crossed with numerous African violet plants to create plants with the desired multi-florescent trait (G). Finally, the quantity of experimentation needed to make or use the invention based on the content of the disclosure is both very high and very low. It would take a very high quantity of experimentation to produce an African violet plant comprising at least one leaf axil that has the multi-florescent trait – applicant exposed 25,000 seeds to radiation and zero gravity for a period of six years with the help of the space program to transform one (1) plant with the multi-florescent trait. However, it would take a very low quantity of experimentation to create a multi-florescent African violet plant by crossing 'SB 4-2 Muflo' or one of its progeny with an African violet plant that has other desirable traits, as the multi-florescent trait discovered appears to be dominant and stably transmissible (H). The WANDS factors, having been weighed, support the determination of non-enablement for the claimed scope since the skilled artisan would have to engage in undue trial and error experimentation to produce an African violet plant comprising at least one leaf axil that has the multi-florescent trait.

Written Description

Claims 1-3 and 7 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims are drawn to any viable African violet seeds and/or plants with more than one inflorescence per leaf axil. In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of a plant, or even a cell, could be described. Therefore the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotype of the claimed plant has been described.)

In this case, the few disclosed embodiments are not representative of the enormous number of products claimed. The claims encompass all African violet plants with a particular inflorescence architecture, regardless of its origin, all African violet plants produced by cross breeding with plants exhibiting a particular inflorescence architecture, and all seeds or plants grown from some deposited seeds. Plants have many phenotypical traits, which vary independently, so millions of possible phenotypes are possible and claimed. The specification discloses only a few specific multi-florescent African Violet plants but not the heterozygous population claimed.

Next, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is not possible to adequately describe the claimed products because the cross of a hybrid plant gives rise to a heterozygous population. One skilled in the art would not be able to predict all of the resulting phenotypes. The limited disclosure in the specification is not deemed sufficient to reasonably convey to one skilled in the art that Applicants were in possession of the huge genera recited in the claims at the time the application was filed. Thus, it is concluded that the written description requirement is not satisfied for the claimed genera.

This rejection could be overcome by limiting the claims to the deposited seeds, plants grown therefrom and their asexually propagated progeny.

Applicant traversed this rejection in response to the first Office Action, and noted that, to date, "traditional breeding techniques failed to produce African Violet cultivars that stably produced more than one flower stem from one leaf node." The Examiner's search of the prior art confirms this; however, Applicant has invented multi-florescent African Violets produced by a specific method and should not be permitted to claim all multi-florescent African Violets produced by any method, as it is impossible to predict whether or not multi-florescent African Violets could be developed by an alternate, non-obvious method during the patent term of the instant claims.

Further, as noted above, some plants that would fall under the scope of the present claims may fall outside the scope of what is reasonably capable of anticipation.

WENDY HAAS, J.D.
PRIMARY EXAMINER





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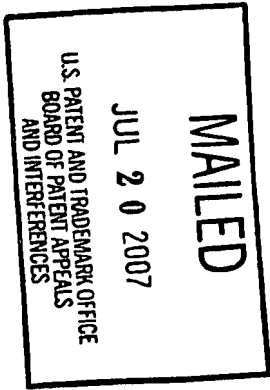
EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REINHOLD HOLTKAMP, SR.

Application 10/046,968

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 18, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal.

Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Examiner's Answer was mailed on February 23, 2006. Section (9) Grounds of Rejection, appearing on page 3, reads as follows:

The Examiner incorporates by reference the Enablement and Written Description rejections set forth in the final Office Action mailed December 2, 2004. The rejections are located beginning with the second paragraph of Page 2 and ending with the third paragraph on Page 6.

According to § 1207.02 of the Manual of Patent Examining Procedure

(MPEP), Eighth Edition, Rev. 3 (August 2005):

An examiner's answer should not refer, either directly or indirectly, to any prior Office action without fully restating the point relied on in the answer.

The Examiner's Answer mailed February 23 2006 is deficient because the examiner has not included an explanation for each ground of rejection.

Correction is required.

In addition, according to the Patent Application Location and Monitoring (PALM), a letter withdrawing/vacating an Office Action was mailed on July 10, 2006. We are unable to locate a copy of this correspondence in the IFW.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to prepare a PTOL-90 which corrects the "Grounds of Rejection";

Application 10/046,968

✓ Please
remove
PALM
entry

- 2) to locate a copy of the missing letter withdrawing/vacating an Office Action which was mailed on July 10, 2006 (according to PALM) and to have a complete copy scanned into the IFW; and
- 3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: Patrick J. Nolan
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN:psb

Foley and Lardner LLP
Suite 500
500 K Street, N.W.
Washington, D.C. 20007

Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 10/046,968	Applicant(s) HOLTKAMP, REINHOLD	
	Examiner Wendy C. Haas	Art Unit 1661	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 24 April 2006 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and **relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):


Please note, MPEP section 1208 stipulates that a reply brief should include a Status of claims page..

WENDY HAAS
PATENT EXAMINER

Wendy Haas

Source of PPTM?

Day : Friday
Date: 8/3/2007
Time: 15:57:12

 **PALM INTRANET**

Content Information for 10/046968

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Appln Info Contents Petition Info Atty/Agent Info Continuity/Reexam Foreign Data Inventors Address Fees

Date	Status	Code	Description
07/20/2007	149	APRD	ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER
07/18/2007	132	APWD	APPEAL AWAITING BPAI DOCKETING
07/07/2007	123	TCWD	APPEAL READY FOR BPAI DOCKETING
01/11/2007		FWDX	DATE FORWARDED TO EXAMINER
09/25/2006	121	AP.B	APPEAL BRIEF FILED
08/24/2006		APBD	NOTICE -- DEFECTIVE APPEAL BRIEF
08/24/2006	120	MW/AC	MAIL NOTICE OF WITHDRAWN ACTION
08/24/2006		APBD	NOTICE -- DEFECTIVE APPEAL BRIEF
08/21/2006		FWDX	DATE FORWARDED TO EXAMINER
09/02/2005	121	APBI	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED
09/02/2005	121	AP.B	APPEAL BRIEF FILED
07/10/2006	121	W/AC	LETTER WITHDRAWING / VACATING OFFICE ACTION
04/24/2006		APOH	REQUEST FOR ORAL HEARING
05/02/2006		FWDX	DATE FORWARDED TO EXAMINER
04/24/2006	128	APRB	REPLY BRIEF FILED
02/23/2006	123	MAPEA	MAIL EXAMINER'S ANSWER

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